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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,379	10/27/2000	Teresa Martineau	MS150499.1	6348

27195 7590 06/09/2005

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EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,379

Applicant(s)

MARTINEAU ET AL.

Examiner

Mark Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 12-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

In reply to restriction requirement mailed 3/30/2005 the applicant has elected Group I (claims 1-11) with traverse. Claims 12-40 are hereby withdrawn from consideration.

Response to Amendment filed with RCE

The examiner is in receipt of applicant's response to office action mailed 5/10/2004, which was received 12/29/2004. Acknowledgment is made to the amendment to claim 1, leaving claims 1-11 as pending in the instant application. The amendment was carefully considered and was convincing, therefore, the following rejection necessitated by amendment follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,5,8 and 9) rejected under 35 U.S.C. 102(e) as being anticipated by Hoang et al (US 6,499,052).

In response to claim 1, Hoang discloses a system that facilitates electronic shopping through an electronic item list for items residing on the Internet comprising:

at least one database holding information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type (col 7, line 45, remote merchant database (RMIS));

an item list database that stores at least one item list that includes a reference to at least one item associated with the information stored in the at least one database (col 7, lines 55-60, local commerce gift registry); and

an interface component that receives a request to display the item that is referenced in the at least one item list (FIG 3), accesses the item list database to obtain the reference from the at least one item (FIG 3, item 318),

utilizes the reference as a key into the at least one database, searches the at least one databases for the referenced item (FIG 3, items 340 and 350),

extracts data corresponding to the referenced item (FIG 3, item 350), and

utilizes the extracted data to display the item and associated information to the requester (FIG 3, item 376).

In response to claim 5, Hoang teaches a remote input component that allows a user to add an item to the item list, the item is a description that resides on a

remote merchant's site, and the remote merchant site employs a link to the remote input component that invokes *the* remote input component (FIG 3).

In response to claim 8, Hoang teaches a component that links an infrastructure of the item list system to a remote site wherein the item list system appears to reside on the remote site (col 8, lines 50-60).

In response to claim 9, Hoang teaches the interface component comprises a plurality of ASP (application service provider) pages (FIG 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang in view of Official Notice.

In regards to claim 2, Hoang teaches referencing a remote site from a local commerce site (col 4, lines line 63) and receiving new information from the remote merchant site (col 7, lines 37-67), but does not specifically mention that the reference information contained in the local commerce site is degraded to assure that the

information is current. It was old and well known in the art at the time of the invention to update local databases with current information received during a search. It would have been obvious to a person having ordinary skill in the art at the time of the invention to degrade the information, because this would prevent the system from continually going to a site that had ceased doing business and lower the customers frustration because the items that were present on the system were not available thus dashing expectations.

In regards to claims 3 and 4, Hoang teaches a gift registry and saving a list of items in the gift registry, but does not specifically mention that the gifts that are wished for are ones that are customized such as personal requests other than products for sale at merchandisers. It was old and well known in the art at the time of the invention to provide gifts that are not store bought and providing personalized requests over the internet. It would have been obvious to a person having ordinary skill in the to include permitting a giftee to add personalized gift items to the registry, because this would allow people to request exactly what they wanted and not limit them to only selected products. This would allow the customer to use one site rather than having to place special requests on a separate site.

Claims 6,7,10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang in view of Robertson (US 6,609,106).

In response to claims 6,7,10 and 11, Hoang teaches a gift registry but does not teach the particulars of the gift registry found in claims 6,7,10 and 11. Roberson teaches the specific elements of the instant claims. It would have been obvious to a person having ordinary skill in the art to include in Hoang the specifics or a registry as taught by Roberson, because this would create an efficient means for accessing the remote information found in the merchant sites.

Response to Arguments

It is noted by the examiner that no arguments were presented with the RCE and amendment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(571) 272-6755**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(571) 272-7159**.

Art Unit: 3625

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is **(571) 272-3600**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including

After Final communications labeled

"Box AF"]

(571) 273-6755 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a long horizontal flourish extending to the right.

Mark Fadok

Primary Examiner